

REMARKS

Upon entry of the instant amendment, claims 21-44 will be pending in the application. By this amendment, claim 29 is amended and claims 41-44 are added. Support for the amendments to claim 29 can be found on paragraph [0015] of the instant published application US 2002/0130902. Support for new claims 41-44 can be found on paragraphs [0016] and [0017] of the instant published application US 2002/0130902. Reconsideration of the rejected claims in view of the above amendments and the following remarks is respectfully requested.

35 U.S.C. §101 Rejection

Claims 29-34 are rejected under 35 U.S.C. §101 as directed to non-statutory subject matter. This rejection is moot.

By this Amendment, claim 29 has been amended in a manner which is believed to resolve this basis of rejection consistent with MPEP 2106. In particular, claim 29 has been amended to recite that the apparatus is implemented with hardware and software. Such language clearly imparts tangible features to the claims, i.e., the language of claim 29 makes clear that the invention is not merely software stored on tangible media.

35 U.S.C. § 103 Rejections***Over Kadowaki with Forecast Pro***

Claims 21, 24, 26, 28-30, 33 and 34 were rejected under 35 U.S.C. § 103(a) over

U.S. Patent No. 6,313,921 to KADOWAKI in view of FORCAST PRO. This rejection is respectfully traversed.

A rejection under 35 U.S.C. § 103(a) requires the Examiner to establish a prima facie case of obviousness: "The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness." M.P.E.P. § 2142.

In this case, at least claims 21 and 29 are allowable over any proper combination of these documents because claims 21 and 29 recite at least one feature that the combination of these documents does not disclose or suggest.

In particular, independent claim 21 recites, among other things:

accessing a content database to retrieve a personalized content object identified by the personalization engine selected by the arbiter; and
passing with the arbiter the personalized content object to an application program.

Additionally, independent claim 29 recites, *inter alia*,

the arbiter selecting a personalization engine from the plurality of personalization engines, and the selected personalization engine selects the at least one personalization content object from the content database; and
the arbiter passing the personalized content object to an application program.

The above-noted documents fail to disclose or suggest at least the above-noted features.

Claim 21

In rejecting claim 21, the Examiner asserts on page 4 that the printer controller of

KADOWAKI is properly interpreted as the recited arbiter and that KADOWAKI teaches accessing a content database to retrieve a personalized content object identified by the personalization engine selected by the arbiter at col. 18, lines 63-67 & col. 19, line 1, and passing with the arbiter the personalized content object to an application program at col. 19, lines 1-3. Applicant disagrees.

Col. 18, line 62 to col. 19, line 11, which encompasses the language identified by the Examiner, does not disclose or suggest accessing a content database to retrieve a personalized content object identified by the personalization engine selected by the arbiter, and instead states the following:

Upon receiving the user ID information and the like from the printer controller 41, the personalizing server 3-1 first checks the user ID information and the password. If the personalizing server 3-1 authenticates that the user is an authorized user, the personalizing server 3-1 extracts personalizing information managed by itself and stored for an apparatus of that user. The personalizing server 3-1 sends this personalizing information, such as shown in FIG. 16B, to the printer controller 41. As shown in FIG. 16B, the personalizing information in the second embodiment contains a cumulative number of printed sheets 65-1 of the current user, an upper-limit number of printed sheets 65-2 of the current user, an available function list 65-3 of the current user, font data 65-4 of the current user, cover sheet image data 65-5 of the current user, and form image data 65-6 of the current user. The printer controller 41 accomplishes personalization by copying this personalizing information to the storage areas 62-1 to 62-6 shown in FIG. 15B.

The above-noted language explains that the printer controller sends user ID information and the like to the personalizing server and accomplishes personalization by copying this personalizing information to the storage areas and that the personalizing server checks user ID information, authenticates the user, and extracts personalizing information. However, this is not the same as accessing a content

database to retrieve a personalized content object identified by the personalization engine selected by the arbiter. Indeed, the Examiner has failed to explain how the above-noted language even remotely discloses that the printer controller 41 selects the personalizing server 3-1. As the Examiner may know, the term “select” means to pick or chose from among several. This is clearly shown in Applicant’s Fig. 3 which shows how the arbiter 310 can select from the personalization engines 325A-325M.

It is also apparent that the above-noted language does not disclose or suggest passing with the arbiter the personalized content object to an application program. Again, while it is true that above-noted language explains that the printer controller sends user ID information and the like to personalizing server and accomplishes personalization by copying this personalizing information to the storage areas and that the personalizing server checks user ID information, authenticates the user, and extracts personalizing information, this is not the same as passing with the arbiter the personalized content object to an application program. Indeed, the Examiner has erred in two ways: first the Examiner has improperly characterized the personalizing server as the recited application program when claim 21 recites, in addition to an arbiter, a personalization engine and an application program; and second, the personalizing server of KADOWAKI is not an application program, and is instead an apparatus, i.e., not software, (see col. 6, lines 55-65).

FORECAST PRO fails to cure the deficiencies of KADOWAKI. First, FORECAST PRO is not properly combinable with KADOWAKI. FORECAST PRO

relates to forecasting software and KADOWAKI relates to printers and printing images. FORECAST PRO has little or nothing to do with printing images and KADOWAKI has little or nothing to do with forecasting. Second, while it can be argued that KADOWAKI teaches an expert system, the disclosed expert system is used for forecasting, and not printing images. Accordingly, there is no basis for using the expert system of FORECAST PRO on the printing system of KADOWAKI.

Claim 29

In rejecting claim 29, the Examiner asserts on page 7 that the printer controller of KADOWAKI is properly interpreted as the recited arbiter and that KADOWAKI teaches the arbiter selecting a personalization engine from the plurality of personalization engines, and the selected personalization engine selects the at least one personalization content object from the content database at col. 18, lines 38-44 and col. 18, line 62 to col. 19, line 11. The Examiner also asserts that KADOWAKI teaches that the arbiter passes the personalized content object to an application program at col. 19, lines 1-3. Applicant disagrees.

Col. 18, line 38 to col. 19, line 11, which encompasses the language identified by the Examiner, does not disclose or suggest the arbiter selecting a personalization engine from the plurality of personalization engines, and the selected personalization engine selects the at least one personalization content object from the content database. Instead, the noted language states the following:

When a description designating personalization is found in a print job, as shown in FIG. 16A, the printer controller 41 sends apparatus ID information 64-2 of the

printer controller 41, machine type ID information 64-3, machine type group ID information 64-4, user ID information 64-5, and a password 64-6 to the personalizing server 3-1 having a certain network address 64-1. The network address 64-1 of the personalizing server 3-1 is acquired as a part of user ID information described in the print job. The apparatus ID information 64-2 uniquely identifies the corresponding apparatus. More specifically, the network address of the printer controller 41 is used. The machine type ID information 64-3 identifies the machine type of printer by a number, e.g., 1 for a type X printer of a company A, 2 for a type Y printer of the company A, and 3 for a type Z printer of a company B. The machine type group ID information 64-4 identifies the machine type group by a number, e.g., 1 for a copying machine, 2 for a facsimile apparatus, and 3 for a printer. The user ID information 64-5 uniquely identifies the current user who has transmitted a print job currently being processed. The password 64-6 authenticates whether the user who has transmitted a print job is a user who is authorized to use the printer. This password 64-6 is acquired as a part of user ID information described in a print job.

Upon receiving the user ID information and the like from the printer controller 41, the personalizing server 3-1 first checks the user ID information and the password. If the personalizing server 3-1 authenticates that the user is an authorized user, the personalizing server 3-1 extracts personalizing information managed by itself and stored for an apparatus of that user. The personalizing server 3-1 sends this personalizing information, such as shown in FIG. 16B, to the printer controller 41. As shown in FIG. 16B, the personalizing information in the second embodiment contains a cumulative number of printed sheets 65-1 of the current user, an upper-limit number of printed sheets 65-2 of the current user, an available function list 65-3 of the current user, font data 65-4 of the current user, cover sheet image data 65-5 of the current user, and form image data 65-6 of the current user. The printer controller 41 accomplishes personalization by copying this personalizing information to the storage areas 62-1 to 62-6 shown in FIG. 15B.

The above-noted language explains that the printer controller sends user ID information and the like to the personalizing server and accomplishes personalization by copying this personalizing information to the storage areas and that the personalizing server checks user ID information, authenticates the user, and extracts personalizing information. However, this is not the same as the arbiter selecting a personalization engine from the plurality of personalization engines, and the selected

personalization engine selects the at least one personalization content object from the content database. Indeed, the Examiner has failed to explain how the above-noted language even remotely discloses that the printer controller 41 selects the personalizing server 3-1.

FORECAST PRO fails to cure the deficiencies of KADOWAKI. First, FORECAST PRO is not properly combinable with KADOWAKI. FORECAST PRO relates to forecasting software and KADOWAKI relates to printers and printing images. FORECAST PRO has little or nothing to do with printing images and KADOWAKI has little or nothing to do with forecasting. Second, while it can be argued that KADOWAKI teaches an expert system, the disclosed expert system is used for forecasting, and not printing images. Accordingly, there is no basis for using the expert system of FORECAST PRO on the printing system of KADOWAKI.

Consequently, Applicant submits that claims 21 and 29 are allowable over KADOWAKI and FORECAST PRO. Furthermore, claims 24, 26, 28, 30, 33 and 34, which recite additional features which, in combination with the features of claims 21 and 29, are not disclosed or suggested by any proper combination of these documents.

Over Kadowaki with Forecast Pro and Jacobi

Claims 22, 31, 32 and 35-40 were rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,313,921 to KADOWAKI in view of FORECAST PRO, and further in view of U.S. Patent No. 6,064,980 to JACOBI et al. This rejection is respectfully traversed.

As explained above, a rejection under 35 U.S.C. § 103(a) requires the Examiner to establish a prima facie case of obviousness: "The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness." M.P.E.P. § 2142.

In this case, at least claims 21, 29 and 35 are allowable over any proper combination of these documents because claims 21, 29 and 35 recite at least one feature that the combination of these documents does not disclose or suggest.

In particular, independent claim 21 recites, among other things:

accessing a content database to retrieve a personalized content object identified by the personalization engine selected by the arbiter; and
passing with the arbiter the personalized content object to an application program.

Additionally, independent claim 29 recites, *inter alia*,

the arbiter selecting a personalization engine from the plurality of personalization engines, and the selected personalization engine selects the at least one personalization content object from the content database; and
the arbiter passing the personalized content object to an application program.

Finally, independent claim 35 recites, *inter alia*,

selecting with an arbiter a personalization engine by analysis of at least one profile element;
selecting with the personalization engine a personalized content object to tailor information provided to the user; and
using the arbiter for on-line shopping.

The above-noted documents fail to disclose or suggest at least the above-noted features.

As regards claims 22, 31 and 32, Applicant reiterates the arguments noted above with regard to claims 21 and 29, and further asserts that JACOBI does not cure the deficiencies of KADOWAKI and FORECAST PRO as regards claims 21 and 29.

In particular, it is submitted that JACOBI fails to cure the deficiencies of KADOWAKI and FORECAST PRO for three reasons. First, JACOBI is not properly combinable with KADOWAKI and FORECAST PRO. FORECAST PRO relates to forecasting software. KADOWAKI relates to printers and printing images. JACOBI relates to collecting ratings from users. FORECAST PRO has little or nothing to do with printing images and collecting ratings from users. Additionally, KADOWAKI has little or nothing to do with forecasting and collecting ratings from users. Finally, JACOBI has little or nothing to do with printing images and forecasting. Second, while it can be argued that FORECAST PRO teaches an expert system, the disclosed expert system is not used for printing images, collecting ratings from users, or on-line shopping. Third, even assuming that JACOBI teaches an arbiter for on-line shopping, the disclosed system is used for collecting ratings from users, and not forecasting and printing images. Accordingly, there is no basis for using the system of JACOBI with the forecasting system of FORECAST PRO and on the printing system of KADOWAKI.

As regards claim 35, the Examiner asserts that KADOWAKI and FORECAST PRO teach all of the features of claim 35 with the exception of using an arbiter for on-line shopping. The Examiner opines, however, that this feature is taught by JACOBI. Applicant disagrees.

While it is true that JACOBI discusses collecting ratings from users in the context of on-line shopping (see Abstract), JACOBI does not utilize a printer controller for on-line shopping. The Examiner will recall that the printer controller of KADOWAKI has been identified as the recited arbiter. The Examiner cannot now change the interpretation of this feature. Unless the Examiner can identify a printer controller in JACOBI which is used for on-line shopping consistent with the language of claim 35, or the Examiner identifies another feature in KADOWAKI that can arguably be used for on-line shopping in JACOBI, there is no basis for combining the teachings of JACOBI with those of KADOWAKI, and vice versa.

Furthermore, it is submitted that JACOBI fails to cure the deficiencies of KADOWAKI and FORECAST PRO for the three reasons noted above regarding claims 21 and 29.

Consequently, Applicant submits that claims 21, 29 and 35 are allowable over KADOWAKI, FORECAST PRO, and JACOBI. Furthermore, claims 22, 31, 32 and 36-40, which recite additional features which, in combination with the features of claims 21, 29 and 35, are not disclosed or suggested by any proper combination of these documents.

Over Kadowaki with Forecast Pro, Jacobi, and Tetzlaff

Claim 27 was rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,313,921 to KADOWAKI in view of FORCAST PRO, and further in view of U.S. Patent No. 6,064,980 to JACOBI et al. and U.S. Patent No. 6,556,963 to TETZLAFF. This

rejection is respectfully traversed.

As explained above, a rejection under 35 U.S.C. § 103(a) requires the Examiner to establish a prima facie case of obviousness: "The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness." M.P.E.P. § 2142.

In this case, at least claim 21 is allowable over any proper combination of these documents because claim 21 recites at least one feature that the combination of these documents does not disclose or suggest.

In particular, independent claim 21 recites, among other things:

accessing a content database to retrieve a personalized content object identified by the personalization engine selected by the arbiter; and
passing with the arbiter the personalized content object to an application program.

The above-noted documents fail to disclose or suggest at least the above-noted features.

Applicant reiterates the arguments noted above with regard to claim 21, and further asserts that TETZLAFF does not cure the deficiencies of KADOWAKI, FORECAST PRO, and JACOBI.

In particular, it is submitted that TETZLAFF fails to cure the deficiencies of KADOWAKI, FORECAST PRO, and JACOBI for three reasons. First, TETZLAFF is not properly combinable with KADOWAKI, FORECAST PRO, and JACOBI. FORECAST PRO relates to forecasting software. KADOWAKI relates to printers and printing

images. JACOBI relates to collecting ratings from users. Finally, TETZLAFF relates to a rule based system for nutrient analysis. FORECAST PRO has little or nothing to do with printing images, collecting ratings from users, and a rule based system for nutrient analysis. Additionally, KADOWAKI has little or nothing to do with forecasting, collecting ratings from users, and a rule based system for nutrient analysis. JACOBI has little or nothing to do with printing images, forecasting, and a rule based system for nutrient analysis. Finally, TETZLAFF has little or nothing to do with forecasting, printing images, and collecting ratings from users. Second, while it can be argued that FORECAST PRO teaches an expert system, the disclosed expert system is used for forecasting, and not printing images, collecting ratings from users, or a rule based system for nutrient analysis. Third, even assuming that JACOBI teaches to use an arbiter for on-line shopping, the disclosed system is used for collecting ratings from users, and not forecasting, printing images, or a rule based system for nutrient analysis. Accordingly, there is no basis for using the system of JACOBI with the forecasting system of FORECAST PRO, the printing system of KADOWAKI, and the rule based system for nutrient analysis of TETZLAFF.

Consequently, Applicant submits that claim 21 is allowable over KADOWAKI, FORECAST PRO, JACOBI, and TETZLAFF. Furthermore, claim 27, which recites additional features which, in combination with the features of claim 21, is not disclosed or suggested by any proper combination of these documents.

Over Kadowaki with Forecast Pro and Kurtzman, II

Claims 23 and 25 were rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,313,921 to KADOWAKI in view of FORECAST PRO, and further in view of U.S. Patent No. 6,044,376 to KURTZMAN, II. This rejection is respectfully traversed.

As explained above, a rejection under 35 U.S.C. § 103(a) requires the Examiner to establish a prima facie case of obviousness: “The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.” M.P.E.P. § 2142.

In this case, at least claim 21 is allowable over any proper combination of these documents because claim 21 recites at least one feature that the combination of these documents does not disclose or suggest.

In particular, independent claim 21 recites, among other things:

accessing a content database to retrieve a personalized content object identified by the personalization engine selected by the arbiter; and
passing with the arbiter the personalized content object to an application program.

The above-noted documents fail to disclose or suggest at least the above-noted features.

Applicant reiterates the arguments noted above with regard to claim 21, and further asserts that KURTZMAN does not cure the deficiencies of KADOWAKI and FORECAST PRO.

In particular, it is submitted that KURTZMAN fails to cure the deficiencies of KADOWAKI and FORECAST PRO for three reasons. First, KURTZMAN is not properly combinable with KADOWAKI and FORECAST PRO. FORECAST PRO relates to forecasting software. KADOWAKI relates to printers and printing images. KURTZMAN relates to selecting advertisements based on user selected files. FORECAST PRO has little or nothing to do with printing images and selecting advertisements based on user selected files. Additionally, KADOWAKI has little or nothing to do with forecasting and selecting advertisements based on user selected files. Finally, KURTZMAN has little or nothing to do with printing images and forecasting. Second, while it can be argued that FORECAST PRO teaches an expert system, the disclosed expert system is used for forecasting, and not printing images or selecting advertisements based on user selected files. Third, even assuming that KURTZMAN teaches to use an application program in the form of a web browser and the internet, the disclosed system is used for selecting advertisements based on user selected files, and not forecasting or printing images. Accordingly, there is no basis for using the system of KURTZMAN with the forecasting system of FORECAST PRO and the printing system of KADOWAKI.

Consequently, Applicant submits that claim 21 is allowable over KADOWAKI, FORECAST PRO and KURTZMAN. Furthermore, claims 23 and 25, which recites additional features which, in combination with the features of claim 21, is not disclosed or suggested by any proper combination of these documents.

New Claims Are Also Allowable

Applicant submits that the new claims 41-44 are allowable over the applied art of record. Specifically, claims 41-44 depend from claims 21 and 29 which are believed to be allowable. These claims also further recite a combination of features which are clearly not disclosed or suggested by the applied art of record. Accordingly, Applicant respectfully requests consideration of this claim and further requests that the above-noted claim be indicated as being allowed.

CONCLUSION

Applicant submits that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicant hereby makes a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 09-0457.

Respectfully submitted,
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